

1 REMARKS

2 Telephone Interview with Examiner Haq

3 On October 14, 2003 applicants' attorney and Examiner Haq discussed the Notice of  
4 Non-Responsive Amendment, in which the Examiner asserted that no support could be found in  
5 applicants' specification for an unencrypted softgood. The Examiner pointed out that portions of the  
6 specification clearly refer to encrypting data exchanged between a purchaser and an e-commerce  
7 server. Applicants' attorney pointed out that such references clearly were directed to the purchaser's  
8 credit card information, and the specification never stated that the softgood itself was encrypted.

9 No agreement was reached as to whether support for an unencrypted softgood is present in  
10 the specification as filed. A subsequent conversation with the Examiner clarified that the  
11 Amendment submitted on July 17, 2003 had not been entered, thus all amendments  
12 presented herein are based on the status of the claims as of the amendment dated  
13 December 24, 2002.

14 Status of the Claims

15 Claims 1-20, 22-41, and 45-48 are pending in the present application, new Claim 48 having  
16 been added in the present amendment. The Examiner has withdrawn Claims 42-44 from  
17 consideration as being drawn to a non elected invention, and Claims 21 and 42-44 were previously  
18 cancelled by applicants. Claims 1-3, 6, 8, 9, 20, 23, 32, 35, 37, 39, and 45-47 have been amended to  
19 more clearly define the invention.

20 Background Comments on Applicants' Invention

21 Applicants believe that a primary aspect of the novelty of applicants' invention is the use of a  
22 player program to control the level of access to a softgood, based upon whether the softgood has been  
23 registered to play on the computer that is executing the player program. Prior art techniques for  
24 preventing unlicensed use of softgoods typically tightly control distribution, and/or encrypt  
25 softgoods, so that only users having access to the proper decryption key can enjoy full use of the  
26 softgood. Applicants' focus has been to provide both authoring tools and player tools; such that  
27 softgoods created using the authoring tool can only be played in a full mode using a specific player  
28 and only after the softgood has been registered on the computer executing the player. The player is  
29 specifically programmed so that unless a registration value for a specific softgood is accessible on the  
30 computer to indicate that a user has actually purchased the specific softgood, the player program will

1 only play the softgood in a demo mode. This approach controls the use of a softgood without  
2 encrypting the softgood.

3 Because the Examiner does not believe that support in the specification enables the element of  
4 an "unencrypted softgood," amendments have been made to the claims to focus on other  
5 distinguishing elements. As will be discussed in detail below, there are portions of applicants'  
6 specification which cannot be logically understood in the context of an encrypted softgood. Such  
7 portions would appear to provide support for the element of an unencrypted softgood, thus that term  
8 does remain in newly added Claim 48.

9 Objection to Claim 46

10 The Examiner has noted that Claim 46 improperly depends from Claim 42, which applicants  
11 previously cancelled. Claim 46 has been amended to depend from Claim 45.

12 Claims Rejected under 35 U.S.C. § 112, First Paragraph

13 The Examiner has rejected Claims 1, 20, and 35 under 35 U.S.C. § 112, second paragraph.  
14 The Examiner asserts that the specification as filed does not enable the claims.

15 Applicants have significantly amended Claims 1 and 20, deleting and/or modifying the  
16 elements that the Examiner has indicated are not enabled, thereby obviating the rejection.

17 With respect to Claim 35, the Examiner asserts that the recitation of "a purchase of a softgood  
18 being initiated when a softgood is being used" is not enabled. However, FIGURE 4 and the text  
19 associated with blocks 110-114 of FIGURE 4 describe a user attempting to play a softgood. The  
20 player determines if the softgood is registered, and if not, the softgood is only played in a demo mode  
21 in block 112. When playing the softgood in the demo mode, the player program prompts the user to  
22 purchase the softgood, as indicated in block 114. Note that FIGURE 1B clearly shows a player  
23 program including a control 22 labeled BUY. Applicants' specification discloses that the BUY  
24 control is displayed during playback of an unregistered softgood, and teaches that clicking the BUY  
25 control initiates the purchase transaction. Thus, the description in applicants' specification clearly  
26 supports and enables the recitation of "a purchase of a softgood being initiated when a softgood is  
27 being used." Accordingly, the rejection of Claims 1, 20, and 35 under 35 U.S.C. § 112, first  
28 paragraph, should be withdrawn.

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1 Claims Rejected under 35 U.S.C. § 112, Second Paragraph

2 The Examiner has rejected Claims 1, 32, 45, and 47 under 35 U.S.C. § 112, second paragraph.  
3 The Examiner asserts that the language employed in the claims is indefinite.

4 As noted above, Claim 1 has been amended to delete language the Examiner asserts is not  
5 enabled by the specification. The Examiner asserted that the same language is also indefinite, and the  
6 amendment to Claim 1 thus addresses the indefiniteness rejection as well.

7 With respect to Claims 32, 45, and 47, applicants respectfully note that the presence or  
8 absence of a registration value does not affect the ability to copy or distribute a softgood. The  
9 Examiner appears to conclude that the recited registration value, and the recited player program that  
10 enables playback in full mode or demo mode based on the presence or absence of the registration  
11 value on the player's computer inherently prevents the copying of a "full version" of the softgood.  
12 However, the Examiner has misunderstood the disclosure of the present invention, since the  
13 specification clearly indicates that one of the intents of the present invention is to encourage the free  
14 copying and distribution of softgoods, in accord with the claimed invention, since only a softgood  
15 that has been registered on a computer (i.e., purchased) can be played by the player program on that  
16 computer. It must be understood that the presence or lack of a registration value has no effect on  
17 whether a softgood can be copied or distributed. In that regard, the present claimed invention only  
18 provides full play protection, as opposed to copy protection, since any copy can be played in demo  
19 mode, but player programs will only enable a softgood to be played in a full mode if that player  
20 program can access a registration value indicating that the softgood can be played in a full mode. If a  
21 registration value for a softgood is not found on the computer, the specific player required to play the  
22 softgood will only enable playback in a demo mode on the computer.

23 While it is true that a softgood is modified to the extent of including the registration value in  
24 the softgood, the registration value is also stored in a registration file resident on the purchaser's  
25 computer. In describing block 134 of FIGURE 4, applicants' specification reads:

26 In a block 134, the softgood is registered on the user's computer, e.g., by  
27 modifying the softgood to include the registration value **and** by making a  
28 corresponding entry in a softgood registration file on the computer. This  
29 registration is checked by the player program to determine if the user has rights  
30 to continue to use the softgood after the allowed preview has been completed  
(page 16, lines 20-24, emphasis added).

1 It is important to understand that both the modified softgood (i.e., the one including the  
2 registration value) and the original softgood both can be copied and distributed freely. Nothing  
3 prevents or discourages either the modified or unmodified softgood from being copied. Further,  
4 neither the modified softgood nor the unmodified softgood (sans registration value) can be played in  
5 the full mode (verses the demo mode) without satisfying the restriction regarding registration on the  
6 computer used to run the player program. The player program installed on a computer on which the  
7 softgood is to be played checks to determine if the softgood is registered on *that* computer. In one  
8 preferred embodiment, the player program looks for both the registration value added to the softgood  
9 *and the registration file on the computer*. If either is missing, the softgood is not properly registered  
10 on that computer, and the player program plays the softgood only in the demo mode. Thus, a  
11 modified softgood will be played in the demo mode on a computer that lacks the registration value in  
12 the softgood registration file stored on that computer. In one embodiment, an unmodified softgood  
13 (i.e., one with no registration value) will be played in the demo mode even if the computer used to  
14 play the softgood has the correct registration value for the softgood, because the registration value is  
15 missing from the softgood itself.

16 Because the registration value affects only the playback of a softgood, as opposed to the  
17 copyability of the softgood, there is no internal contradiction. As described above, the softgood  
18 alone, with or without a registration value, never solely controls the playability of the softgood.  
19 Playability of the softgood is a function of registration, which includes the existence of the proper  
20 registration value either in both the softgood and the softgood registration file, or at least on the  
21 computer (depending upon the embodiment). The Examiner has stated that a registration value is  
22 inherently a form of copy protection, since it prevents the user from making a copy of the full  
23 version. However, applicants do not use the softgood registration as copy protection. As recited in  
24 applicants' claims, *the softgoods do not include any copy protection that prohibits the softgoods*  
25 *from being freely copied and freely distributed*. The registration value does not prevent the softgood  
26 from being freely copied or distributed. Applicants want the softgoods to be widely copied and  
27 distributed, so that the demo play receives the greatest exposure. The registration value controls the  
28 playability of the softgood in full mode, and not copying or distribution. Accordingly, the rejection  
29 of Claims 32 and 45 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

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1 The Examiner has also asserted that an indefiniteness rejection can be supported when an  
2 apparatus claim includes functional limitations, citing relatively old case law, including a 1959  
3 decision. Applicants submit that the apparatus claims define structure, including processors that are  
4 programmed to carry out specific functions when the processors execute machine instructions. The  
5 current version of the MPEP makes it clear that functional limitations cannot provide the sole basis  
6 for a rejection. While the Examiner is correct in stating that the claims include functional limitations,  
7 the use of functional language is simply not justification for the rejection of an apparatus claim.  
8 MPEP 2173.05(g) clearly states that:

9 A functional limitation is an attempt to define something by what it does,  
10 rather than by what it is (e.g., as evidenced by its specific structure or specific  
11 ingredients). There is nothing inherently wrong with defining some part of an  
12 invention in functional terms. Functional language does not, in and of itself,  
render a claim improper.

13 It was held that the limitation used to define a radical on a chemical compound  
14 as "incapable of forming a dye with said oxidizing developing agent" although  
15 functional, was perfectly acceptable because it set definite boundaries on the  
16 patent protection sought.

17 Clearly, the current version of the MPEP (i.e., the online version of Edition 8, including the  
18 revisions of February 2003) indicates that the use of functional limitations is acceptable according to  
19 PTO policies and procedures. The cases cited in MPEP 2173.05(g) supporting the use of functional  
20 limitations in apparatus cases are CCPA decisions that are newer (issued in 1971) and appear to  
21 overrule the 1959 CCPA case cited by the Examiner. The newer CAFC case cited by the Examiner,  
22 *Hewlett-Packard Co. v Bausch & Lomb Inc.*, does not support the Examiner's assertion, since the  
23 quoted passage was taken out of context by the Examiner. Specifically, the full quote is:

24 Secondly and more importantly, there is no requirement, as B&L implies, that  
25 HP show "operational differences" of the claimed device over the prior art. Claim 1 of  
26 LaBarre is an apparatus claim, and apparatus claims cover what a device is, not what a  
27 device does. An invention need not operate differently than the prior art to be  
patentable, but need only be different. (CAFC) 15 USPQ2d 1525, 1528.

28 The statement quoted by the Examiner was not made to show that the claims in the LaBarre patent  
29 were invalid. Instead, the court made the statement to affirm that the claims were valid even though  
30 they did not distinguish over the prior art based on functionality. Thus, the federal circuit court

1 simply noted that a claim that structurally distinguishes over prior art does not need to also  
2 functionally distinguish over the prior art to be patentable. The federal circuit court did not state that  
3 claims cannot distinguish over prior art by including functional limitations. Further, the current  
4 version of the MPEP specifically states that functional limitations are not in and of themselves  
5 improper. Current PTO policy and procedure indicates that Claims 32 and 47 cannot be rejected  
6 simply for including functional limitations.

7 The MPEP makes its clear that an analysis must be made as to whether the functional  
8 limitations define boundaries on the protection being sought. If the functional limitations are so  
9 vague that the boundaries are indefinite, then an indefiniteness rejection is appropriate. However,  
10 applicants' Claims 32 and 47 recite definite boundaries on the patent protection sought using  
11 functional language, and as such, are not indefinite. Accordingly, the rejection of Claims 32 and 47  
12 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

13 Claims Rejected under 35 U.S.C. § 103 over Wiser

14 The Examiner has rejected Claims 1, 3, 4, 6, and 7 under 35 U.S.C. § 103(a) as being obvious  
15 over Wiser (U.S. Patent No. 6,385,596) in view of applicants' admission of prior art (APA). The  
16 Examiner asserts that Wiser discloses each element recited in applicants' claims, except for a media  
17 file that is unlocked using a code provided upon purchase. Wiser' teaches a media file that is  
18 streamed to a user for preview, and if purchased a copy of the media file specifically encrypted with  
19 the purchaser's passport and sent to the user. During playback, the passport must be available. To  
20 share a copy playable in full mode with others, the purchaser must provide not only the file, but also  
21 his passport including confidential information (i.e. credit cards). The Examiner appears to conclude  
22 that because downloadable demo software that can be unlocked with a code provided upon purchase  
23 was known (APA), it would have been obvious to modify Wiser's method to use a purchase code  
24 rather than a passport system, to avoid having to send a second copy to the purchaser. The  
25 combination cited by the Examiner does not appear to render the amended claims obvious for the  
26 following reasons.

27 The Examiner has noted that the APA refers to unlocking stand alone software to provide full  
28 functionality rather than the limited demo version of the software. The Examiner has indicated that it  
29 would be obvious to combine Wiser with a key to unlock a demo version of software, to prevent a  
30 purchaser from having to make two downloads (presumably a stream of the preview and then a

1 purchased copy in which the full version is encrypted with the purchaser's passport). While the  
2 Examiner is correct that Wiser's system is awkward to use, because the media file encrypted with the  
3 purchaser's passport is not downloaded until purchase, that point really goes to the heart of how  
4 Wiser controls undesired distribution of the softgood, which is entirely different than the free  
5 distribution of softgoods promoted by applicants' claimed invention. If, as the Examiner suggests,  
6 Wiser were modified so that a locked media file was downloaded, after a purchase a key was sent to  
7 unlock the full version, the purchaser would then be in possession of an unlocked full version, which  
8 could be copied and distributed so that others who had not paid could also enjoy the full version –  
9 which is clearly not desirable from the standpoint of the copyright owner. Thus, it is not apparent  
10 how the protection afforded by Wiser's passport could be integrated with the unlocked software  
11 disclosed in the APA, and the Examiner's proposed modification does not achieve applicants'  
12 claimed invention. It should be noted that the standalone software noted by applicants (the APA) is  
13 described as being distinguishable from softgoods, because softgoods require a computing device and  
14 a specialized player program, while the APA requires only a computing device. Further, the APA  
15 suffers from the disadvantage that once unlocked, the software can be freely copied and used on  
16 multiple computing devices. This has been a problem in the software industry for years, and only  
17 recently have such stand alone software products included activation technology designed to thwart  
18 such unauthorized distribution of unlocked software.

19       Significantly, the modification suggested by the Examiner would eliminate the inherent  
20 protection of including a purchaser's private confidential data in a passport required to play the  
21 softgood. That confidential data inhibits purchasers from freely sharing a softgood playable in full  
22 mode, because presumably that person will be reluctant to also give away his personal information,  
23 such as his credit card number. Not only does the modification suggested by the Examiner provide  
24 no mechanism to prevent copies of the unlocked version of the softgood from being freely  
25 distributed, Wiser teaches against such a modification, as Wiser clearly teaches that 'some private  
26 information be linked to the softgood playable in full mode to inhibit the free distribution of that fully  
27 playable softgood.

28       Even if such a combination of the teachings of the prior art were made, the softgood  
29 registration used by a player program as recited by applicants is not disclosed or suggested either by  
30 Wiser or the APA, so an equivalent invention is not achieved. The present claimed invention

1 distinguishes over the cited art by the use of a player that controls the playability of a softgood based  
2 on the softgood registration being accessed on the computer used to play the softgood with the player  
3 program, as recited in the amended independent claims. Accordingly, the rejection of Claim 1 and  
4 the other related dependent claims as being obvious over Wiser in view of the APA should be  
5 withdrawn. Because dependent claims are patentable for at least the same reasons as claims from  
6 which they depend, the rejection of Claims 3, 4, 6, and 7, each of which depend from Claim 1, should  
7 also be withdrawn.

8 With respect to the Examiner's comments on page 6 of the Office Action dated  
9 March 17, 2003, the Examiner asserts that streaming does not preclude downloading. It should be  
10 noted that Wiser specifically uses the term streaming in discussing preview, and notes that selected  
11 free portions of a media file might be downloaded during preview. Upon purchase, an entire media  
12 file is transmitted to a user. It seems clear that Wiser differentiates between the data provided during  
13 preview and the data provided after purchase. Not only is the purchased media file specifically  
14 encrypted based on the purchaser's passport, but it is certainly not clear that the entire media file is  
15 provided during preview. As for the Examiner's comment that Wiser explicitly teaches that a  
16 consumer should be able to pass on preview music to other potential customers, that comment was  
17 provided in the Background of the Invention section of Wiser's disclosure, and never mentioned with  
18 respect to Wiser's description of his system. Not only does that statement not provide strong support  
19 for concluding that Wiser must send a full copy of the media file to a prospective purchaser during  
20 preview, it should be noted that Wiser's streaming of selected data to a potential purchaser would still  
21 enable the free portion of the media file to be distributed to friends. Further, once a purchaser has  
22 obtained the full version of the media file, the purchaser could give the media file to a friend, without  
23 also giving his passport. Thus the audio images could not be decrypted, and the friend could only  
24 access the free portion of the media file. Sharing only free portions of the media file that were  
25 downloaded during preview (as opposed to the entire media file) or sharing already purchased media  
26 files enables softgoods that can be previewed to be distributed. This answers the Examiner's  
27 question as to how such distribution can be achieved if the entire media file is not provided during the  
28 streaming of preview data. This points out to a distinction between how applicants' method  
29 distributes softgoods and Wiser distributes softgoods.

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1       Wiser discloses several distinctly different types of softgoods. One type of softgood is a media  
2 file 200, which includes encrypted audio images 208, artist descriptive data 204, and clip and song  
3 information 214. Wiser makes it clear that clip and song information 214 is not encrypted, so that users  
4 may preview the softgood without needing to decrypt audio image 208 (see column 7, lines 56-62). As  
5 noted above, during preview portions of the media file are streamed, and that the streaming is executed  
6 based on media instructions that define how much of the softgood is to be played in preview  
7 (column 15, lines 56-61). During preview, a free download may be offered (column 16, lines 6-8),  
8 presumably a clip or artist notes, as opposed to encrypted audio images 208 required to enjoy the  
9 softgood in a full mode. Significantly, the softgood that will actually be played in full mode by the  
10 purchaser has not yet been distributed to the potential purchaser. As is clearly disclosed in the section  
11 of Wiser entitled PURCHASE (column 16, line 26 to column 20, line 9), for a softgood to be played in  
12 full mode the softgood is encrypted using the passport of the purchaser, and that uniquely encrypted  
13 softgood (i.e. licensed media file 200) is delivered to the purchaser. If the purchaser were to give that  
14 softgood to a friend, the friend could only access the free portion (clip information 214) of the media  
15 file, not encrypted audio image 208. For the encrypted audio image (the only softgood that can be  
16 played in full mode) to be usable, the passport of the purchaser, which contains sensitive data, must also  
17 be given to the friend, providing a disincentive for sharing the passport that enables full mode to be  
18 accessed. Thus, a softgood that can be played in full mode or demo mode is not distributed *until*  
19 purchase. Prior to purchase, only selected free clips are available. In the present invention, the  
20 softgood that can be played in the demo mode or full mode is distributed *prior* to purchase.

21       With respect to Claim 6 in particular, as amended Claim 6 recites that the registration value  
22 for the purchased softgood transmitted by the agency includes an identity of the purchaser, so that the  
23 registration value for the softgood that was purchased cannot be registered on an additional  
24 computing device to enable a copy of the specific player program installed on the additional  
25 computing device to playback the softgood in the full mode, unless the purchaser is identified as an  
26 authorized user of the additional computing device. Neither the APA or Wiser teach or suggest any  
27 mechanism for registering a softgood on more than one device based on a determination of whether a  
28 purchaser is an authorized user of the other device. Thus no combination of Wiser and the APA can  
29 achieve an equivalent invention. For this additional reason the rejection of Claim 6 as being obvious  
30 over Wiser in view of the APA should be withdrawn.

1 Claim 2 as Rejected under 35 U.S.C. § 103 over Wiser in view of Rinearson

2 The Examiner has rejected Claim 2 under 35 U.S.C. § 103(a) as being obvious over Wiser  
3 (U.S. Patent No. 6,385,596), in view of APA, and further in view of Rinearson, which teaches that all  
4 documents created by Microsoft Corporation's WORD™ word processing program include the DOC  
5 extension. Claim 2 has been amended to make it clear that the unique identifier specifically identifies  
6 the specific copy of the creator program used by the creator from all copies of the creator program.  
7 The specification indicates this feature can be achieved with a unique identifier based on the serial  
8 number of the creator's copy of the creator program. The combination cited by the Examiner is not  
9 equivalent to the amended claim. Accordingly, the rejection of Claim 2 as being obvious over the  
10 cited art and the APA should be withdrawn. Further, as noted above, Claim 1 is distinguishable over  
11 the cited art, and Claim 2 is patentable for at least the same reasons.

12 Claim 5 as Rejected under 35 U.S.C. § 103 over Wiser in view of Rinearson

13 The Examiner has rejected Claim 5 under 35 U.S.C. § 103(a) as being obvious over Wiser  
14 (U.S. Patent No. 6,385,596) in view of Stefik (U.S. Patent No. 5,629,980), further in view of the  
15 APA. As noted above, Claim 1 is distinguishable over the cited art, and Claim 5 is patentable for at  
16 least the same reasons.

17 Claims Rejected under 35 U.S.C. § 103 over Wiser, and in view of Official Notice

18 The Examiner has rejected Claims 8-12, 14, 17-19, 32, 35-37, 39-41, 45, and 47 under  
19 35 U.S.C. § 103(a) as being obvious over Wiser (U.S. Patent No. 6,385,596) in view of Official  
20 Notice. As discussed above, applicants have amended the independent claims to recite use of a  
21 registration value for each softgood, which is stored in a registration file on the computer the player  
22 program resides on. The player program will not play the softgood in a full mode unless the  
23 corresponding registration value is accessible on the computer executing the player program. As  
24 amended, each of the rejected independent claims is patentable for the following reasons.

25 In addition to reciting use of a registration value for each softgood purchased, Claim 8 recites  
26 that during preview (i.e., play of the softgood in the demo mode), the user has a complete copy of the  
27 softgood, regardless of how the softgood was obtained. Wiser indicates that when a softgood is  
28 obtained over a network for preview (as opposed to a friend giving a copy of the softgood without the  
29 passport, so only clip information as opposed to audio images can be used) control over what portions  
30 of a media file a prospective purchaser has is based on the e-commerce server (column 15,

1 lines 44-61). During preview, the e-commerce server (i.e. delivery server 118) determines what  
2 portion of the media file is streamed to the prospective purchaser. As discussed in detail above,  
3 Wiser does not state that the entire media file is made available during preview. The present  
4 invention provides the full version of the softgood to prospective purchasers regardless of how the  
5 softgood is distributed (i.e. obtained online from an e-commerce server or traded among friends).  
6 Access to the softgood is controlled by a player program based on a registration value.

7 Furthermore, the cited art does not teach an equivalent registration value. As discussed  
8 above, Wiser's player uses a passport to decrypt audio images, whereas applicants' player controls  
9 the play (demo or full mode) based on registration values. Claim 8 recites that the registration value  
10 is used by the player to control the mode of play, and that each registration value is based on the  
11 softgood's unique identifier. Wiser does not teach or suggest an equivalent registration value, and as  
12 discussed above a combination of Wiser and the APA would achieve a softgood that is always  
13 unlocked upon purchase. Further, modifying Wiser to use registration values as opposed to passports  
14 contradicts Wiser's specific teaching that both passports containing sensitive personal information are  
15 to be used to inhibit users from sharing softgoods that can be played in a full mode.

16 To achieve an equivalent invention, Wiser must be modified to use registration values to  
17 unlock a locked softgood as disclosed in the APA, Wiser must be modified to transmit entire media  
18 files during preview, and Wiser's player program must be modified to control playability based on a  
19 registration value. The APA only teaches using registration values to unlock software, not a player  
20 program that uses registration values to control playability between a demo mode and a full mode. A  
21 combination of Wiser and the APA would achieve a softgood that is unlocked with a registration  
22 value, such that the unlocked softgood could be played in full mode and freely copied.

23 With respect to the Examiner's comments about modular programming, it appears that the  
24 Examiner asserts that any function implemented by one program can obviously be implemented in  
25 another program. Taken to a logical extreme, no software program can be novel unless it includes a  
26 function never before implemented. That does not appear to be an accepted test for patentability.  
27 Furthermore, the references to which the Examiner has cited refer to the mechanical arts. The  
28 rejected claim is a method, not a structure. There is no basis to conclude that merely because making  
29 a two piece structure a one piece structure is not novel, such a concept should be extended to  
30 methods, such that if individual steps are known then when combined in a new order such steps

1 cannot be novel. The cited art does not teach or suggest player programs that can be used to initiate a  
2 purchase over a network. Conventionally, such purchases are implemented in a browser program, not  
3 a player program. The art to which the Examiner has cited has noted that the *function* of a two piece  
4 handle and the *function* of a one piece handle are identical. In the context of the present invention,  
5 the function of a player program that can facilitate a network purchase and the function of a web  
6 browser and the function of a conventional player program have some overlap, but are not identical  
7 (web browsers are not players, and players are not browsers). There appears no basis to conclude that  
8 the case law cited by the Examiner is intended to be applied to methods, or is intended to be applied  
9 to circumstances in which functions of the invention differ from the functions of the prior art.

10 The invention recited in applicants Claim 8 is not equivalent to the distribution method  
11 disclosed by Wiser, nor can Wiser be obviously combined with other cited art to achieve an  
12 equivalent invention. Claims 13-19 depend on Claim 8, and are patentable for at least the same  
13 reasons. Accordingly, the rejection of Claims 8-12, 14, and 17-19 as obvious over Wiser in view of  
14 Official Notice should be withdrawn.

15 Referring now to independent Claim 32, it appears the Examiner believes that Wiser discloses  
16 a registration value as being part of a registration process. The Examiner cites to specific portions of  
17 Wiser to support this (column 3, lines 32-50, column 9, lines 25-36, and column 10, lines 1-37). In  
18 actuality, those sections describe the encryption of audio image 208 (part of Wiser's media file)  
19 based on the purchaser's passport, so that the encrypted audio image 208 can only be played when a  
20 player has access to both the media file with the encrypted content and the passport of the purchaser,  
21 which must be used to decrypt the encrypted portion of the file. While it is true that in the present  
22 invention a softgood is only played in a full mode if the softgood and a registration value are present  
23 on the computer, the passport of Wiser and the registration value of the present claimed invention are  
24 not equivalent. The passport is issued to a user and is common to encrypting and decrypting all of  
25 the softgoods purchased by the user in Wiser's method. Regardless of the number of media files  
26 purchased, the same passport is used to encrypt and decrypt all of the softgoods purchased by the  
27 user. In contrast, applicants' claimed registration values are each unique to a specific softgood, such  
28 that for a library of 25 purchased softgoods, there will be 25 corresponding registration values, each  
29 associated only with a different one of the purchased softgoods. Until a user purchases a softgood, no  
30 registration value for that softgood is present on the user's computer. In contrast, according to Wiser,

1 a passport is required before the purchase of any media file, and the same passport is used to encrypt  
2 and decrypt the full content of the media file.

3 Furthermore, the player in the present invention controls the mode of playback based on the  
4 presence or absence of the registration value on the computer executing the player. Claim 32 clearly  
5 recites that the step of providing a registration value upon purchase of a softgood, adding the  
6 registration value to a registration file, and checking for a registration of the softgood on the purchaser  
7 computer to determine if the softgood is to be played in a demo mode or a full mode. Wiser describes  
8 decrypting an encrypted softgood only if the required passport is available. The manner in which  
9 applicants' player controls the playback of the softgood is clearly distinguishable over the technique  
10 employed by Wiser, and for the reasons discussed above a combination of the APA and Wiser do not  
11 achieve an equivalent invention. Accordingly, the rejection of Claim 32, and each claim depending  
12 on Claim 32, as being obvious over Wiser in view of Official Notice, should be withdrawn.

13 Claim 35 provides that a player selects a mode of play (full versus demo) based on the  
14 presence of a registration value, and provides for initiating a purchase of a softgood that is being  
15 played in the demo mode. As noted above, Wiser controls playback based on a correspondence  
16 between a passport and an audio image encrypted using passport data. Claim 35 further recites that  
17 purchase can be initiated when a softgood is used. The Examiner has asserted that it would have  
18 been obvious to add such a feature to Wiser's method, as concurrency is known. Applicants'  
19 specification describes that the purchase is initiated within the player program with the use of a BUY  
20 control displayed by the player program. The Examiner appears to believe that while not disclosed or  
21 suggested by Wiser, such functionality is obvious, because modular programming is known.  
22 Enabling a purchase to be initiated and executed from within a player program, as opposed to from  
23 within a web browser, is not disclosed in any art cited by the Examiner. Regardless of whether  
24 modular programming techniques or concurrency techniques *could* be used to achieve such  
25 functionality, the desirability of such functionality and the actual functionality is not taught or  
26 suggested in the cited art, and there appears no basis to conclude that such functionality merely  
27 represents an obvious integration of functions. Wiser does suggest that a purchaser could give a  
28 friend a softgood without the required passport, such that the friend can only use free (or preview)  
29 portions of the softgood. There is simply no suggestion in Wiser that when such a preview is provided  
30 by a player program that the player program prompt the user to buy the softgood. Asserting that

1 because concurrency is known and such steps would therefore be obvious appears to impermissibly  
2 rely on hindsight.

3 Claim 35 distinguishes over the cited art because of the recited registration value controlling  
4 the mode in which a softgood is played, and because it would not have been obvious to modify Wiser  
5 to initiate a purchase of a softgood from within a player program when playing the softgood.  
6 Accordingly, the rejection of Claim 35, and each claim depending on Claim 35, as being obvious  
7 over Wiser in view of Official Notice, should be withdrawn.

8 Independent Claims 45 and 47 each recite the registration value being used for controlling the  
9 playability of the softgood, i.e., in full or demo mode. As discussed above, such recitation  
10 distinguishes Claims 45 and 47 over the cited art. As discussed above, such recitation distinguishes  
11 Claims 45 and 47 over the cited art. Accordingly, the rejection of Claims 45 and 47, and each claim  
12 depending on such claims, as being obvious over Wiser in view of Official Notice, should be  
13 withdrawn.

14 Claim 45 additionally recites a player program that prompts a prospective purchaser to buy a  
15 softgood if the player program cannot access a registration value indicating an authorized user of the  
16 computer on which the player program resides has already purchased the softgood. The cited art does  
17 not teach or suggest a player program that prompts a purchase.

18 Claim 47 additionally recites elements that do not appear to be disclosed in the prior art. For  
19 example, Claim 47 recites machine instructions that implement the function of communicating with  
20 the database on the remote computer over the network to determine if an authorized user of the  
21 purchaser computer has previously purchased the softgood that is to be played, if a registration value  
22 corresponding to the unique identifier of the softgood that is to be played has not been provided to the  
23 purchaser computer. If it is determined that an authorized user of the purchaser computer has  
24 previously purchased the softgood that is to be played, the machine instructions defining the player  
25 program enables playback of the softgood so as to provide access to its full range of benefits.

26 Wiser does not teach a player program that contacts an e-commerce agency to determine if an  
27 authorized user of the computer on which the player program resides has purchased the softgood to  
28 be played. Wiser's player either has a passport matching the encryption of the softgood, or Wiser's  
29 program does not have the correct passport, thus only preview is supported. The APA discloses  
30 software that is locked or unlocked, and does not teach or suggest contacting an e-commerce agency

1 to see if an authorized user of the computer has purchased the software. For these additional reasons,  
2 Claims 45 and 47 are distinguishable over the cited art.

3 Claims Rejected under 35 U.S.C. § 103 over Ronning and Richardson in view of Official Notice

4 The Examiner has rejected Claims 20, 22-24, and 31 under 35 U.S.C. § 103(a) as being  
5 obvious over Ronning (U.S. Patent No. 5,883,955) in view of Official Notice, and further in view of  
6 Richardson (U.S. Patent No. 5,490,216). Applicants have amended Claim 20, and as amended  
7 Claim 20 is patentably distinguished over the cited art for the following reasons.

8 Ronning discloses sending encrypted software over a network. The software is configured to  
9 enable preview while encrypted, and full use when decrypted. Upon purchase, the purchaser is sent  
10 the decryption key. Once the software is decrypted, the purchaser has the ability to make and  
11 distribute duplicate copies of the decrypted full version. Ronning's method enables software to be  
12 distributed over a network with some degree of security, but undesirable distribution after the  
13 purchase of a single copy is not prevented, because once unlocked the purchased version can be  
14 copied and distributed, and used fully by other non paying user's. In contrast, the present invention  
15 as defined in Claim 20 recites a player program being configured to determine if the unencrypted  
16 softgood is registered on the computer on which the player program is installed before enabling  
17 playback of a softgood, so that if a particular softgood is not registered on the computer on which the  
18 player program is installed, the player program enables playback of the particular softgood in a demo  
19 mode, and if the particular softgood is registered on the computer on which the player program is  
20 installed, the player program enables playback of the particular softgood in a full mode, wherein the  
21 registration is implemented by providing a registration value, a different registration value being  
22 required for each softgood. By focusing on controlling the mode of playing a softgood with a player  
23 program, not based on any encryption of the softgood, but instead on the basis of a registration value  
24 for the softgood that is accessible by the computer with which the softgood is to be played, the  
25 present invention prevents unlicensed use of the softgood – but without limiting the distribution,  
26 copying, or sharing of the softgood. Significantly, softgoods in accord with the present invention are  
27 not wrapped in the secure envelope used for the software described by Ronning.

28 The combination suggested by the Examiner will not result in an invention equivalent to  
29 applicants' claimed invention because there is no suggestion to modify Ronning so that the  
30 playability of softgoods are based on a registration value, as opposed to whether a locked/encrypted

1 softgood is unlocked. Accordingly, the rejection of Claim 20, and each claim depending on  
2 Claim 20, as being obvious over Ronning in view of Official Notice, and further in view of  
3 Richardson, should be withdrawn.

4 Dependent Claims as Rejected under 35 U.S.C. § 103 over Various Art

5 The Examiner has rejected Claims 13, 15, 16, 25-29, 30, 33, 34, and 38 under  
6 35 U.S.C. § 103(a) as being obvious over various combinations of cited art. As discussed in detail  
7 above, independent Claims 1, 8, 20, 32, and 35 each are distinguishable over the cited art; and thus,  
8 each of Claims 13, 15, 16, 25-29, 30, 33, 34, and 38 are patentable for at least the same reasons.

9 New Claim 48, Restriction and the Enablement of Unencrypted Softgoods

10 New Claim 48 has been added, further defining the softgoods as being unencrypted. It  
11 appears that the Examiner believes that more narrowly defining the softgoods both merits a  
12 restriction, and a rejection that such unencrypted softgoods are not enabled in the specification.

13 With respect to whether narrowing the definition of a softgood (an originally recited element)  
14 merits a restriction, applicants note at best it appears that claims directed to *unencrypted* softgoods  
15 could be considered to be an additional species. There does not appear to be a basis for considering  
16 claims directed to unencrypted softgoods as being independent, because clearly there is a relationship  
17 between claims including the element of softgoods, and claims including the element of unencrypted  
18 softgoods. Clearly, the term softgoods encompasses both encrypted and unencrypted softgoods, thus  
19 claims directed to unencrypted softgoods are related to claims directed to softgoods.

20 With respect to species restrictions, MPEP 806.04 indicates that a reasonable number of  
21 species can be included in the same application,. Referring to MPEP 806.05, claims reciting  
22 softgoods can be considered to be AB<sub>br</sub> (A corresponding to other elements, B corresponding to  
23 softgoods, and <sub>br</sub> corresponding to softgoods being defined broadly), while claims reciting  
24 unencrypted softgoods can be considered to be AB<sub>sp</sub> (A corresponding to other elements, B  
25 corresponding to softgoods, and <sub>sp</sub> corresponding to softgoods being defined narrowly).  
26 MPEP 806.05 does not indicate that such claims ought to be restricted.

27 While the narrowing of softgoods to unencrypted softgoods might arguably be considered to  
28 raise an issue requiring an additional search, it does not appear to require a restriction to be issued.

29 Referring now to the enablement of unencrypted softgoods, a careful analysis of the  
30 specification as filed does not support either a conclusion that unencrypted softgoods are inconsistent



1 with the specification, or that unencrypted softgoods lack enablement. Initially, it must be recognized  
2 that the term softgoods logically encompasses *both* encrypted and unencrypted softgoods, unless the  
3 specification includes disclosure clearly excluding a particular type of softgood. The Examiner is  
4 correct that applicants' specification teaches that *some* of the data transmitted to and from the e-  
5 commerce server can be, and in some cases preferably is, encrypted. Specifically, the specification  
6 states the following:

7 If a credit card or other financial account number is included in the  
8 transmission from the player program to the e-commerce server, the player  
9 program will encrypt the transmission to minimize the risk that a third party  
10 may intercept it and gain access to the user's credit card information. The  
11 player program preferably encrypts this transmission automatically, in  
12 response to entry of a credit card or other financial account number in the  
dialog, so that the user is not involved in even making the decision to encrypt  
the transmission (page 12, lines 15-22).

13 A block 44 in FIGURE 1B indicates that the transmission is sent over the  
14 Internet (or other network) to the e-commerce server, which decrypts the  
15 transmission (if encrypted). Also included in the transmission, although not  
16 evident to the user, is a user identification that provides the user's name, for  
17 association with the credit card or other financial account number. The  
18 e-commerce server automatically connects to a credit card or other financial  
19 account approval service over the Internet (or over an alternative network), as  
20 indicated in a block 46, to determine if the user's financial account number is  
21 valid and if the transaction is approved. The communication between the  
e-commerce server and the approval service is preferably conducted through a  
secure socket layer (SSL) connection or other secure connection to ensure the  
security of the data being transmitted between the two entities by preventing  
interception of the communication by a third party (page 12, lines 23-34).

22 The registration value or ID for a softgood may be encrypted, or encoded by  
23 logically combining binary values for these three variables (page 13, lines 9-  
24 11).

25 In a decision block 130, the e-commerce server determines if the credit card or  
26 other financial account information has been approved by the approval agency  
27 and if so, a block 132 indicates that the e-commerce server logs the transaction  
28 and sends a softgood registration value or ID (which may be encrypted or  
29 encoded) to the player program, and optionally e-mails the registration value or  
30 ID to the user (page 16, lines 15-20).

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1 Clearly, the only data specifically disclosed as being encrypted are the purchaser's financial  
2 data (preferably encrypted), and the registration value (optionally encrypted). The softgood is *never*  
3 described as being encrypted. The Examiner has asserted in the above noted telephone interview that  
4 encrypted credit data and encrypted registration values imply encrypted softgoods.

5 It must also be noted that applicants' specification clearly describes softgoods being  
6 distributed over a network, or *via distribution of memory media on which the softgood is stored*  
7 (page 4, lines 21-22). Even if all softgoods distributed over a network are assumed to be encrypted  
8 (and there is no disclosure providing firm support for such a conclusion), there is no basis for  
9 concluding that softgoods distributed via memory media are encrypted. The present invention is  
10 clearly directed to controlling the playability of a softgood by configuring a player program to require  
11 a registration value to enable full playback, else playing the softgood in a demo mode. Encryption of  
12 the softgood does not affect the player program's control of playback.

13 It also must be recognized that encryption of softgoods requires some decryption before the  
14 softgood can be used, and no such decryption process of the softgood is described, which clearly  
15 ought to imply that the softgoods are unencrypted. Furthermore, applicants' specification clearly  
16 teaches that a goal of the invention is that people *will* copy and widely distribute the softgoods.

17 An important underlying premise in the economic model used for marketing  
18 softgoods and selling them in accord with the present invention is that the  
19 softgoods be freely distributed over the Internet and through other distribution  
20 channels to provide as many shared copies of the softgood to prospective  
21 purchasers as possible, thereby maximizing the opportunity for preview and  
22 sale of the softgoods, as indicated in a block 104. The Internet or other  
23 network provides an expedient way to achieve this widespread distribution  
24 (page 14, lines 21-27).

25 The present invention assumes that the softgoods will be freely distributed  
26 through rampant copying and other mass distribution techniques to ensure the  
27 widest possible preview of the softgoods, thereby tending to increase the  
28 numbers of prospective purchasers who will be interested in purchasing the  
29 softgoods (page 17, lines 9-11).

30 Each softgood thus distributed will be playable in a demo mode until the computer the player  
program resides on receives a registration value indicating the player program can play the softgood  
in a full mode. If the softgood was encrypted, then the distribution scheme noted above could not be

1 supported, as prospective users would have no way to decrypt the softgood to preview it. Thus  
2 encrypted softgoods are logically inconsistent with a fundamental aspect of the present invention, and  
3 it is not logical to conclude that the specification implies that the softgoods are encrypted. It is  
4 significant to note that in the context of the present invention encryption of the softgood provides no  
5 benefit (as the softgood cannot be played in full mode without the registration value), and that  
6 encryption would require providing some undisclosed mechanism to enable prospective purchasers to  
7 decrypt the softgood to preview it. There is more evidence to support a conclusion that the  
8 specification inherently discloses unencrypted softgoods, rather than implies encrypted softgoods.  
9 The conclusion that unencrypted softgoods are inconsistent with and not enabled by the specification  
10 does not appear well founded, thus Claim 48, which recites unencrypted softgoods, is further  
11 distinguishable over the cited art.

12  
13 In view of the preceding amendments and remarks, it will be apparent that all claims in this  
14 case define a novel and non-obvious invention. The application is in condition for allowance and  
15 should be passed to issue without further delay. Should any further questions remain, the Examiner  
16 is asked to telephone applicants' attorney at the number listed below.

17 Respectfully submitted,

18  
19 *Ron Anderson*

20  
21 Ronald M. Anderson  
22 Registration No. 28,829

23 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed  
24 envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, P.O.  
Box 1450, Alexandria, VA 22313-1450, on October 31, 2003.

25 Date: October 31, 2003

26 RMA/MCK:  
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*Kathy Davline*